

## **REMARKS**

Claims 6-27 presently stand rejected under 35 U.S.C. 103(a) as being unpatentable over Buchanan et al. (U.S. Patent No. 5, 148,366) in view of Griggs (U.S. Patent No. 4,435,617). Applicant has amended the claims as shown above, and has added new claims 28-53. Applicant respectfully traverses the rejection.

MPEP 2142 states that in order for a *prima facie* case of obviousness to be established, among other things, the reference or combinations of references must teach or suggest all the claim limitations. Applicant submits that the combination of Buchanan et al. and Griggs lacks the teaching of at least several of the claim limitations in independent claims 6, 13 and 22.

Specifically, as an initial matter, the combination of Buchanan et al. and Griggs does not disclose or suggest anything related to a testimonial proceeding (such as a deposition or a court or administrative proceeding, for example) or exhibits relating to the testimonial proceeding, as claimed by Applicant. For this reason alone, the rejection should fail.

In addition, however, the combination of Buchanan et al. and Griggs does not disclose or suggest at least the following: (1) respecting claim 6, "*data storage that stores data representative of an image of at least one second document relating to the transcription proceeding, the at least one second document comprising an exhibit*" and "*a screen that displays the first document comprising the transcript text as it is produced and the image of the at least one second document comprising the exhibit for viewing*", (2) respecting claim 13, "*data storage that stores data representative of an image of at least one second document relating to the testimonial proceeding, the at least one second document comprising an exhibit*" and a "*processor, as the transcriber produces the transcript text, directing display on the screen of the first document comprising the transcript text and the image of the at least one second document comprising the exhibit for viewing*", and (3) respecting claim 22, "*displaying the first document comprising the transcript text on the screen for real time viewing*", and "*displaying on the screen an image of the second document comprising the first exhibit.*"

In contrast, Buchanan et al. discloses a document generation system that uses "boiler plate" for enhancing or replacing the dictation and transcription process (such as disclosed in Griggs) for the creation of a document. Buchanan et al. does not disclose or suggest storage of

data representative of *an image* of at least one second document *related to* (and *in addition to*) the document being generated, or the display of the image of that at least one second document, or that the at least one second document comprises an exhibit, as claimed by Applicant.

Buchanan et al. therefore also only deals with a single document that is being created.

Moreover, Griggs does not make up for this deficiency in Buchanan et al. There is no discussion or suggestion in Griggs whatsoever of storage of data representative of *an image* at least one second document *related to* the testimonial proceeding and thus the document being created, or the display of the image of that at least one second document, that the at least one second document comprises an exhibit as claimed by Applicant. Griggs therefore also deals with only a single document that is being created.

Thus, the combination of Buchanan et al. and Griggs only deals with a single document that is being created, and does not disclose or suggest the storage and display of *an image* of at least one *second* document comprising and exhibit that is *related to* the testimonial proceeding and thus the document being created.

In contrast, as more completely discussed above, Applicants' claims are generally directed to at least two different documents, namely, the transcript text (i.e., the document being created) *and* at least one document comprising and exhibit related to the testimonial proceeding (and thus related to the transcript text). Applicant's independent claims 6, 13, and 22 recite data storage that stores data representative of *an image of* at least one second document comprising an exhibit and display of *the image of* the at least one second document comprising the exhibit.

As an illustrative example, Applicant's claimed invention enables, during a testimonial proceeding, an attorney or judge, for example, to view an image of a document that has been entered into evidence as an exhibit, for example, as well as scrolling testimony (i.e., transcript text) from a witness who is testifying about the exhibit while the testimony is being taken, both on a single screen, for example. The combination of Buchanan et al. and Griggs does not disclose or even suggest this capability.

With regard to the Examiner's Remarks section starting on page 5 of the Office Action, Applicant points out that the Examiner misquoted Applicant's arguments. Specifically, as set forth more completely above and in Applicant's prior response, Applicant argued with respect to claim 6 that the combination of Buchanan et al. and Griggs does not disclose or suggest at least

"data storage that stores data representative of *an image of at least one document relating to the transcription proceeding.*" In response, the Examiner states in the Remarks section that the Buchanan et al. reference discloses the limitation of "data storage that stores data representative of at least one document." The Examiner, however, simply does not address the remaining limitations quoted above. The Buchanan et al. reference simply does not disclose storage of "data representative of *an image of at least one second document relating to the testimonial proceeding.*" Buchanan et al. does not mention or even suggest storing an *image* of a document, and has nothing to do with a testimonial proceeding or related exhibits, and thus cannot meet this claim limitation. The portion of Buchanan et al. relied upon by the Examiner for support, namely, col. 4, lines 3-68, simply discusses the word processing capabilities of the Buchanan et al. device for the creation of a document. Accordingly, the rejection should fail for this reason alone.

In addition, however, the Examiner states that the Griggs reference discloses a screen a screen *that displays the transcript text as it is produced and the image of the at least one document for viewing.* Again, however, Griggs discusses or suggests nothing of displaying an *image* of another document in addition to the transcript being produced. The portion of Griggs relied upon by the Examiner for support, namely, col. 3, lines 58-68 and col. 4, lines 1-14, simply mentions that the Griggs system may include a display and discusses background information relating to a speech controlled phonetic typewriter. Accordingly, the rejection should also fail for this reason alone.

Furthermore, MPEP also states that in order for a *prima facie* case of obviousness to be established, there must also be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The Examiner has not set forth any suggestion or motivation to combine the references as the Examiner has done. In fact, the Buchanan et al. system was developed to replace systems such as that in Griggs, and thus a person of ordinary skill in the art would never look to combine those references. Accordingly, the rejection should further fail for this reason alone.

Finally, with regard to the rejections of claims 7-12, 14-21 and 23-27, those claims depend from claims 6, 13 and 22, respectively, and also include the limitations discussed above. Therefore, based on at least the above arguments, Applicant believes that the rejection of all

claims 6-27 under 35 U.S.C. §103 in view of the combination of Buchanan et al. and Griggs has been overcome.


Applicant has also added new claims 28-53, which are similar in many respects to claims 6-27. Applicant believes that these claims are allowable for many if not all of the same reasons discussed above respecting claims 6-27.

In view of the fact that over four years have passed since Applicant paid the issue fee in this case, and the fact that three different Examiners have now examined this case, Applicant respectfully requests that the present case be allowed and be passed back to publications in an expedited manner. Should the Examiner disagree that the claims are allowable or believe that any issues remain unresolved, Applicant respectfully requests a phone interview with the Examiner and the Examiner's supervisor.

Applicant encloses herewith a Request for a Three-Month Extension of Time. Applicant also encloses a \$1762.00 check including (1) the amount of \$950.00 to cover the associated large entity extension fee, and (2) the amount of \$812.00 to cover the large entity extra claims fees.

A Supplemental Notice of Allowability is courteously solicited. Please direct all telephone inquiries to the undersigned at (312) 775-8108.

Respectfully submitted,

By. 

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